



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

DN

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

08/529,354 09/18/95 FLEISCHMAN

S 1928-D-CON

021836 QM12/0301
HENRICKS SLAVIN AND HOLMES LLP
SUITE 200
840 APOLLO STREET
EL SEGUNDO CA 90245

EXAMINER

SHAY, D

ART UNIT

PAPER NUMBER

3739

DATE MAILED:

03/01/00

36

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/524,345

Applicant(s)

Flacshman et al

Examiner

J. Shay

Group Art Unit

3739

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on November 30, 1999
- ☒ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 13, 16, 17, 19, 20, 28, 30, 32, 33, 35, 36 + 38 - 45 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 13, 16, 17, 19, 20, 28, 30, 32, 33, 35, 36 + 38 - 45 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 33
- ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

Art Unit: 3739

The Examiner notes that applicants assesment is correct: "Eggers et al ('443)" does indeed refer to U.S. Patent No. 5,366,443, and "Imran" does, in fact, refer to U.S. Patent number 5,156,151. The Examiner appologizes for any inconvenience caused by this oversite.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 13, 16, 19, 20, 28, 30, 33, 35, 36, 38, and 39 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Eggers et al ('443).

Claims 17, 32, and 40-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggers et al ('443) in combination with Imaran ('151). Eggers et al ('443) teach ^{dr} a device claimed except for the helical electrode or strip electrode. Imran ('151) teaches a metal strip electrodes. It would have been obvious to the artisan of ordinary skill to employ strip electrode, as taught by Imaran ('151) since these are not critical, provide no unexpected result ^{dr} and would enable radially symetric ablation, to employ helical electrodes, since these are not critical and provide no unexpected result, and to allow the device to operate in bipolar mode, since this not critical and provides no unexpcted result, thus producing a device such as claimed..

Claims 41-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggers et al ('443) in combination with Desai ('198). Eggers et al ('443) teach a device such as claimed, except manually operable switches per se. Desai ('198) teaches the equivalence of control via manually operated switches and computer controlled switches for controlling ablation. It would

Art Unit: 3739

have been obvious to the artisan of ordinary skill in the art to employ manually operated on off switches since these are recognized equivalents in the art to computer control, as taught by Desai ('198) thus producing a device such as claimed..

Applicant argues that the independent claims call for producing the claimed combinations of electrodes through which ablating energy is allowed to pass and through which transmission is blocked is done through "input commands" are allowable over Eggers et al ('443). The Examiner must, respectfully, disagree. It is clear that the switching of the electrode in Eggers et al ('443) must occur due to some predetermined command which is input to the electrode controller. It is unclear how applicant can assert the contrary. The Examiner respectfully requests, that if applicant is to continue arguing along these lines, that exactly what is lacking in the commands of Eggers et al ('443) which are input to the controller of the electrodes that prevent the commands from being "input commands" as argued by applicant be specifically pointed out.

Applicant's arguments with respect to claims 13, 16, 17, 19, 20, 28, 30, 32, 33, 35, 36 and 38-45 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

Art Unit: 3739

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to David Shay at telephone number (703) 308-2215.

David Shay:bhw
February 8, 2000



DAVID M. SHAY
PRIMARY EXAMINER
GROUP 330